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**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/413,384 10/06/99 WHEAT

W 31223-74058

025264  
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HOUSTON TX 77267-4412

IM52/0214

EXAMINER

JACKSON, M

ART UNIT

PAPER NUMBER

1773

DATE MAILED:

02/14/01

*5*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/413,384

Applicant(s)

WHEAT ET AL.

Examiner

Monique R Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 25-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The amendment filed 10/6/99 has been entered. Claims 13-24 of the original application have been canceled. New claims 27-30 have been added. Claims 1-12 and 25-30 are pending in the application. The Examiner believes that the Applicant intended to cancel all of the methods claims of the original application, Claims 13-26, which would include Claims 25-26. However, it is noted that Claims 25-26 of the original application (SN 08/953523, USPN 5,997,679) remain in the present application though it appears that they were patented in the original application.

#### *Specification*

2. The disclosure is objected to because of the following informalities: Page 8, line 1 lacks the US Patent Application serial number to which is referred at the end of page 7.

Appropriate correction is required.

3. The use of the trademarks "IRGANOX" and "IRGAFOS" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

#### *Double Patenting*

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 25-26 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 16-17 of prior U.S. Patent No. 5,997,679. This is a double patenting rejection.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-12 and 27-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 4, 6, and 7 recite the limitation "core layer formed of ethylene-propylene copolymer" contains/containing "ethylene in an amount..." followed by a weight percent range, however, the limitation does not provide a basis for this weight percentage, ie. based on the total weight of the core layer, based on the total weight of the copolymer, based on the weight of the propylene and ethylene content in the copolymer, etc.

8. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 28 recites the limitation "[t]he method of claim 9" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102/103***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-12 and 27-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Peiffer et al (USPN 5,573,723.) Peiffer et al teach a biaxially-oriented multilayer film having a base layer comprising an isotactic propylene homopolymer or a copolymer which is predominantly composed of propylene units wherein copolymers of ethylene and propylene have an ethylene content of less than about 10% by weight; and at least one additional layer comprising a material which can be readily subjected to corona treatment such as ethylene/propylene copolymer or polypropylene (1:59-61; 2:34-36; 4:2-5; Examples 1 and 4.) Peiffer et al further teach an example comprising a three-layered film having a total thickness of 25 $\mu$ m wherein two outside layers each have a thickness of 0.4 $\mu$ m (Example 1.) In terms of bond strength, considering the invention taught by Peiffer et al is the same as that of the instant invention, the propylene film would inherently have the same inter-layer bond strength as the instantly claimed invention. Therefore, the invention taught by Peiffer et al anticipates the invention claimed in the present application. Further, it would have been

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obvious to one having ordinary skill in the art to optimize layer and film thickness and the percentage of ethylene in the propylene copolymer using routine experimentation to provide the desired film properties for a particular end use.

12. Claims 1-12 and 27-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Peiffer et al (USPN 5,716,570.) Peiffer et al teach a biaxially oriented polypropylene film comprising a base layer of propylene polymer A and propylene polymer B which contain in general a propylene polymer from 90-100% by weight, in particular 98-100% by weight, of propylene units, based on the weight of the polymer and wherein the propylene polymer is an isotactic polypropylene or copolymers with less than 10% ethylene and polymer A and polymer B have different residual ash content (2:55-58; 3:3-10; 3:58-67; 4:35-42.) Multilayer films can be produced comprising at least one outer layer or layers, if necessary on both sides, which contains or contain in general from 75-100% by weight based in each on the weight of the outer layer(s) of polymers of olefins having 2-10 carbon atoms such as propylene homopolymer, copolymer of ethylene-propylene, terpolymer of ethylene-propylene-butylene, etc (5:36-6:21.) The total thickness of the films depends on the intended use but preferred embodiments have total thicknesses from 2-100 $\mu$ m, with outer layer or layers preferably in the range from 0.1-10 $\mu$ m, with any interlayer(s) present from 0.5-15 $\mu$ m, and the thickness of the base layer obtained from the difference between the total thickness of the film and the thickness of the applied outer layer(s) and interlayer(s) (6:44-61.) In terms of bond strength, considering the invention taught by Peiffer et al is the same as that of the instant invention, the propylene film would inherently have the same inter-layer bond strength as the instantly claimed invention. Therefore, the invention taught by Peiffer et al anticipates the

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invention claimed in the present application. Further, it would have been obvious to one having ordinary skill in the art to optimize layer and film thickness and the percentage of ethylene in the propylene copolymer using routine experimentation to provide the desired film properties for a particular end use.

13. Claims 1-12 and 27-30 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Peiffer et al (USPN 6,063,482.) Peiffer et al teach a biaxially oriented polypropylene film comprising a base ply essentially consisting of an isotactic propylene polymer having at least 90% by weight, in particular 98 to 100% by weight of propylene units and the corresponding comonomer content of not more than 10% by weight, or 0 to 2% by weight, ethylene (Abstract; 3:48-53.) In a preferred multilayer embodiment, the polypropylene film comprises at least one top ply or if necessary top plies on both sides, composed of polymers of  $\alpha$ -olefinic polymers having 2 to 10 carbon atoms, such as propylene homopolymer, copolymer of ethylene and propylene, or terpolymer of ethylene and propylene and 1-butylene (5:28-6:8.) Preferred embodiments of the polypropylene film according to the invention are three-ply wherein the structure, thickness and composition of a second top ply can be chosen independently of the top ply already present (6:46-52.) The thickness of the top ply or plies is generally greater than 0.1 $\mu$ m and is preferably in the range of 0.1 to 10 $\mu$ m (6:54-58.) The thickness of the interlayer or interlayers is generally greater than 0.3 $\mu$ m and preferably in the range of 1.0 to 15 $\mu$ m (6:59-66.) The total thickness of the polypropylene film according to the invention may vary within wide limits and depends on the intended use but it is preferably 4 to 100  $\mu$ m, with the base ply accounting for about 40 to 100% of the total film thickness (7:1-5.) In terms of bond strength, considering the invention taught by Peiffer et al is the same as that of

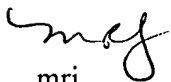
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the instant invention, the propylene film would inherently have the same inter-layer bond strength as the instantly claimed invention. Therefore, the invention taught by Peiffer et al anticipates the invention claimed in the present application. Further, it would have been obvious to one having ordinary skill in the art to optimize layer and film thickness and the percentage of ethylene in the propylene copolymer using routine experimentation to provide the desired film properties for a particular end use.

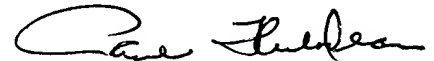
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5436 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



mrj  
February 11, 2001



Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700